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RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MIREILLE MAUBRU, et al.

Appeal 2007-3896
Application 09/759,530
Technology Center 1600

Oral Hearing Held: March 12, 2008

Before DONALD E. ADAMS, ERIC B. GRIMES, and JEFFREY N. FREDMAN, *Administrative Patent Judges*.

ON BEHALF OF THE APPELLANTS:

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The above-entitled matter came on for hearing on Wednesday, March 12, 2008, commencing at 1:27 p.m., at the U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Dawn A. Brown, Notary Registration No. 7066896, Notary Public.

1 THE CLERK: Calendar Number 24. Appeal Number 2007-
2 3896. Attorney Louis Troilo.

3 JUDGE ADAMS: Good afternoon, Mr. Troilo. We're familiar
4 with your issues. Can you begin by introducing your associate and spelling
5 your name for the record?

6 MR. TROILO: My name is Louis Troilo, T-R-O-I-L-O. I'm
7 with the law firm of Finnegan Henderson. We represent the appellant in this
8 case. With me is Nicholas Uhler, U-H-L-I-R. He is also with Finnegan
9 Henderson.

10 Good afternoon. Thank you for hearing this case today. Just to
11 give you a quick roadmap of the argument today. I just want to talk quickly
12 about the claimed invention, the important parts of it, and discuss it in view
13 of the prior art.

14 Specifically, going over the four references that were cited by
15 the examiner, briefly summarizing the examiner's position regarding those
16 references and the teachings, and then getting into the arguments for
17 patentability that are of record and that we'd like to highlight today in this
18 proceeding.

19 And finally, I'd like to address the case law that has changed
20 since we filed our appeal brief, specifically the KSR decision.

21 I'd like to start off with our claimed invention. It is directed to
22 a, as you know, chemical composition or cosmetic composition -- I'm sorry,
23 requiring four components: A washing base, an amphoteric starch, cationic
24 polymer, and silicone, and prohibiting or excluding one component, which is
25 fatty acid. It is free of fatty acid.

26 Our position is that, and has always been that, we have not

1 invented any of these four components, but what we did discover and was
2 not known at the time of the discovery was the composition that resulted
3 from these four components and the unique properties associated with that
4 composition. That is what I'd like to highlight today.

5 The four pieces of prior art are broken up by the examiner and
6 we'll follow this.

7 JUDGE GRIMES: Before you start talking about the prior art,
8 I think -- when I was reading the examiner's formulation of the rejection, it
9 seemed to me it didn't connect the dots of the prior art as logically as it could
10 have. And so if I could just present to you what I think is the most relevant
11 parts of the prior art, maybe we can cut to the issues that have been
12 bothering us.

13 MR. TROILO: Absolutely. That is great.

14 JUDGE GRIMES: Your claims have, essentially, four
15 components in the composition. The Murray reference discloses a hair-
16 conditioning shampoo that has an anionic surfactant, which, I believe, is a
17 washing base within the scope of your claims.

18 They also have a cationic deposition polymer, and in column 5,
19 about line 55, it talks about including an insoluble silicone in the shampoo
20 composition.

21 If you look at the working examples in column 6 of Murray,
22 two of the four contained Carbopol 980, which they don't say what it is, but
23 in the Sweger reference, it teaches that Carbopol -- in this case, Carbopol
24 940 -- I'm sorry. In Sweger, column 8, line 4, it refers to the Carbopol, and
25 in the table there, it is Carbopol 940.

26 In the Sweger reference, as well, we have these amphoteric

1 starches being disclosed as thickeners and emulsion-stabilizing agents. The
2 example, columns 8 and 9, it says that these starches are superior to the
3 Carbowol standard.

4 Then in Babenko, in column 5, line 23, it suggests using the
5 same amphoteric starches in shampoos.

6 So it seems to me that reading the references, regardless of how
7 the examiner put them together, the logical way to combine them is by
8 saying it would be obvious to combine the shampoo composition disclosed
9 by Murray with the amphoteric starches disclosed by Sweger and Babenko
10 and substituting those amphoteric starches for the Carbowol used in Murray
11 on the basis of Sweger's disclosure that the starches are superior as
12 thickeners.

13 So if we can take that combination of the references and
14 address that, I think that would be more useful than trying to walk through
15 the way the examiner laid them out.

16 MR. TROILO: Just to clarify, the way you would set up the
17 rejection, you would have Murray as the primary reference modified with
18 Babenko and Sweger.

19 JUDGE GRIMES: I'm just looking at Claim 1.

20 MR. TROILO: Murray is the primary reference with the other
21 two as a secondary reference.

22 JUDGE GRIMES: We can characterize it that way. That
23 would be a logical way to put them together.

24 MR. TROILO: I'll try to address that in my arguments now. I
25 don't disagree with anything you say, the way you characterize the
26 references, but I still think the issue would come down to what those

1 references teach in combination. And as you pointed out, Murray discloses
2 Carbopol 940 or probable Carbopol. I don't think it is specifically 940.

3 But as you pointed out, the Sweger reference actually teaches
4 the amphoteric starch is better than a Carbopol at columns 8 and 9.
5 Specifically, column 9, lines 1 through 3 talk about superior to Carbopol.

6 To me, if you were making that combination, it would almost
7 be teaching away that -- Murray teaches one thing and Sweger is teaching
8 that, you know, it would be teaching away from that.

9 JUDGE FREDMAN: We agree. In teaching away from
10 Carbopol, the compound of Sweger, which would then be your invention.
11 You don't want Carbopol; you're using a substantive starch.

12 MR. TROILO: Yeah, I think -- one of the things Murray does
13 teach is and one of the things I don't think was brought up in the examiner's
14 rejections is the unpredictabilities when combining these references.

15 Murray discloses very limited elements for suspending silicone.
16 Silicone is very difficult to suspend in this types of compositions just by
17 nature of silicones themselves.

18 And I think while Murray requires the use of Carbopols and
19 silicone-suspending agent, there is nothing of record that indicates that the
20 Sweger starches will be -- exhibit an equivalent or much less superior
21 properties.

22 I would still think there would be an issue of motivation or
23 predictability in such a combination because --

24 JUDGE FREDMAN: Is there anything on the record that says
25 it is unpredictable to use different emulsifiers to emulsify the solution?

26 MR. TROILO: The predictability?

1 JUDGE FREDMAN: Is there any evidence on the record of
2 that to support that position? Does Murray say that expressly?

3 MR. TROILO: Murray -- I don't think Murray says it
4 expressly. I think Sweger says when talking about how one would be
5 starches versus Carbopol. I'm sorry if I'm answering in the opposite. I'm
6 looking at Sweger as the primary.

7 Sweger is the one who is discussing the superior properties on it
8 or the difficulty of using certain emulsifiers or suspending agents, how one
9 can be proved over another. And I think, Judge Grimes, the table on column
10 8 you referenced teaches that.

11 The inventive compositions of Sweger in A and B don't contain
12 that Carbopol. The examiner makes the assertion, well, this shows that
13 starches are superior to Carbopol.

14 I don't think that is the case. If you actually look at this table, it
15 is not the just the starches or Carbopol; it is a combination of secondary
16 emulsifiers.

17 Our position has been on the record it is a combination of
18 elements that is unpredictable. You can't just swap one for another because
19 in reality, there are secondary emulsifiers in control, too, that are not in
20 inventive example A, column E in that.

21 I don't think you can just say that switching one for another
22 would give you predictable results because this is not strictly a mechanical
23 invention or at all a mechanical invention. The variables that exist in
24 choosing the specific materials and their properties are what make it
25 inventive over the prior art.

26 I'm not sure if that answered your question.

1 I think that the bottom line with regard to that argument is that
2 it is more than just Carbopol. There is secondary emulsifiers that the
3 examiner admits during the prosecution history that are not taught in the
4 inventive versus comparative example.

5 JUDGE GRIMES: Isn't the Carbopol characterized as a
6 thickener in the reference?

7 MR. TROILO: It is characterized -- if you give me just one
8 second, I think the way to characterize it --

9 JUDGE GRIMES: Column 8, line 4.

10 MR. TROILO: If you go down column 8 to line 41 through 45,
11 it talks about Carbopol and secondary emulsifiers have the best skin feel and
12 appearance.

13 I'm trying to envision the type of rejections that that
14 combination is going to be made if Murray is the primary reference. Is it
15 simply that it would have been obvious to switch Carbopol for starch?

16 JUDGE GRIMES: It seems to me if you took Murray as an
17 exemplary composition and assuming based on the Sweger's characterization
18 of the Carbopol that the Carbopol in the example 2 and 3 is a thickener, and
19 if you modify those by substituting the starch for the Carbopol as suggested
20 by Sweger's results, you would get something within the scope of the claims.

21 I realize we're catching you off guard, but if you could point out
22 something about that conclusion that is not correct, that would be helpful.

23 MR. TROILO: Sorry I didn't look at it in that combination.

24 JUDGE GRIMES: I understand.

25 MR. TROILO: I would still -- I would still think that the issue
26 would, essentially, be the same that we have with the current rejection. If

1 the motivation for such a rejection is no components being -- exhibiting a
2 known function, I think that greatly simplifies the invention because it is
3 more than just what is out there and what is known.

4 Almost any chemical or -- sorry -- cosmetic composition could
5 be rejected under the same theory that --

6 JUDGE FREDMAN: I mean, but Sweger does give you a little
7 bit of reason to do it, right? Column 8, line 42. CEPA potato starch
8 replacing Carbopol and without secondary emulsifiers have the best skin feel
9 and appearance.

10 The implication there is even without secondary emulsifiers,
11 you take Carbopol and dump in the CEPA instead, it is better. It is not even
12 -- this is more of a teaching or motivation suggestion almost.

13 We have this reference that says it is better to use potato starch
14 than Carbopol when you don't have a secondary emulsifier. If you use
15 Murray as the primary reference using Carbopol, why doesn't that
16 representation say we want to do this?

17 MR. TROILO: Well, I think, again, it is something that the
18 individual elements is in the vacuum as to how they're used in combination.
19 I think if you look at the complete teachings of Sweger to the extent it talks
20 about using such starches in detergent compositions it clearly discusses that
21 with fatty acid soaps, which was excluded.

22 So looking at it just -- the complete teachings of the reference,
23 the proper way to do it, I think, you avoid having the expectation of
24 achieving the successes we had with our composition.

25 And I think individually all these components -- that is how I
26 started off. All these components are known in the prior art. It is just a

1 matter of having to arrange and get it to the composition without we feel our
2 specification has as a guideline, as an improper guideline, one skilled in the
3 art would have come up with this.

4 JUDGE GRIMES: It is more than just a matter of all the
5 components being known in the prior art, though, right? I mean, it is the --
6 the aqueous medium, the washing base, the cationic polymer, and the
7 silicone are all standard components of a conditioning shampoo according to
8 Murray. And Murray doesn't indicate any particular need for fatty acid
9 soaps in such a composition.

10 The only difference really is this amphoteric starch, which is
11 also known in the art. It is not as if we're choosing from a whole bunch of
12 difference types of cosmetic compositions. We have a list of everything in
13 the shampoo except for the starch. Really, the only question is, would there
14 be motivation? Would there be a reason to combine a known starch with a
15 known shampoo composition?

16 MR. TROILO: That is a good question. Obviously, the
17 examiner didn't apply the rejection that way, so we didn't analyze it that
18 way. Looking at Murray, if the benefit -- look at it this way. The benefit
19 described in Sweger you get an improved feel on the skin from the
20 composition, an improved thickening, properties like that.

21 Whether those benefits are described in Murray the same way
22 or if they would have been obvious, that combination hasn't been looked at.
23 The references weren't applied that way.

24 JUDGE ADAMS: As your time winds down, I'd like to revisit
25 just one issue. Once we presented this rearrangement of the elements of the
26 rejection and your first initial response was well, gee, this has silicone in it.

1 Since silicone is known to be such a problem emulsifier, one would not
2 necessarily look to another reference and apply these starches from these
3 other references.

4 This other reference into this Murray reference, the question I
5 have for you, and I think I'm revisiting this is, is there evidence on this
6 record with regard to the silicone having a problem, emulsifying silicone in
7 this type of composition?

8 MR. TROILO: That was an argument that was addressed, and
9 we're going back to 2003 when Murray was applied against the reference. I
10 think it is called Villa. It is no longer of record. Because it is not a current
11 rejection on appeal, I don't have that exact proof, but it was an issue that we
12 addressed when we argued against combination of Villa and Murray.

13 JUDGE ADAMS: You opted not to present that argument in
14 this rejection?

15 MR. TROILO: It wasn't -- we didn't present it because the
16 issue was never presented by the examiner in the rejection that -- that is what
17 I said. Had that been applied -- if the references were applied the way we
18 just discussed, the reorder of Murray and Villa, but at this point it wasn't --

19 JUDGE ADAMS: These references were in front of you, right?
20 You had access to references, right?

21 MR. TROILO: Absolutely. But Villa is no longer on appeal.
22 It is not an objection on appeal. We didn't present it in our appeal brief.
23 Had we, we would have been outside the scope of the rejections.

24 JUDGE ADAMS: I'm not sure why that would be because your
25 claim requires silicone. These references have silicone. Why would you
26 guys be outside the scope of this rejection?

1 MR. TROILO: Villa was in combination with Murray. Villa is
2 not of record anymore.

3 JUDGE ADAMS: Different type of starch or different type of
4 ingredient, right?

5 MR. TROILO: I can't remember what that rejection was. That
6 was in 2002/2003 time period. I don't remember the last time it was --

7 JUDGE ADAMS: That is fine. Any closing comments?

8 MR. TROILO: Absolutely. One thing I did want to address is
9 the KSR decision, and just to get on record that, you know, it is something
10 that -- obviously, we wrote our appeal brief when we filed this case before
11 the KSR decision.

12 But what, obviously, the Court has done in the KSR decision is
13 loosen the standard, for lack of a better word, loosen the standard for
14 determining the obviousness of the combination and allow things like
15 common sense to come into play or predictable solutions and terms like that.

16 If you go through the KSR decision in view of the rejection of
17 record -- I know we just discussed a rejection not on of record -- but as far as
18 a rejection of record, I think all the language used by the Court clearly points
19 to nonobviousness of our current claims.

20 And if I could just list those quickly. I think predictability,
21 there is nothing of record to show predictability of modifying what is now
22 the primary references, Sweger and Babenko, because they either teach
23 away or teach different emulsions not being claimed by our invention.

24 Similarly, we've shown unexpected results from combinations
25 or components in the absence of one component of fatty acid soaps in the
26 form of lightness, hold, and suppleness of hair when it is being applied.

1 That is our three examples in the specification.

2 And common sense, which the Court says should take into
3 account. If you just look at it, I'm sure we've all used shaving cream before
4 at some point, and you just feel the difference.

5 A common-sense approach to thinking you could just substitute
6 one component for another and get the same properties. It may work in KSR
7 where you have the simple mechanical invention, but when you have
8 multiple variables.

9 And it is not a finite number of components you're choosing
10 from; it is a vast number of components. I know we limit it here in view of
11 this reordered rejection, but absent our specification, there has been no
12 motivation to use those four components in the absence of fatty acid soaps.
13 And I think the primary references support that. They show fatty acid soaps.

14 And that is about it. I'm assuming if -- this is more of a
15 question -- that if the rejection is reordered the way you propose, then it will
16 be sent back to the examiner.

17 JUDGE ADAMS: We haven't made any conclusions.

18 MR. TROILO: Just -- but with the rejection of record, we've
19 addressed the issues the way it was presented to us and the way we respond
20 to the Court.

21 JUDGE ADAMS: Any more questions?

22 Thank you.

23 (Whereupon, the proceedings at 1:51 p.m. were concluded.)
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